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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,454	10/29/2003	Kotoyoshi Murakami	740613-140	4569
22204	7590	04/18/2005		
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			EXAMINER STONER, KILEY SHAWN	
			ART UNIT 1725	PAPER NUMBER

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/695,454	MURAKAMI, KOTOYOSHI	
	Examiner	Art Unit	
	Kiley Stoner	1725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5-17-04 10-29-03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 1-4 are objected to because of the following informalities:

In claim, line 10 "threaed" must be changed to --threaded--. Appropriate correction is required.

In claim 10, line 16, "an distal" must be changed to --a distal--.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-4 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4 of copending Application No. 10/500,389. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagao (JP-2002137067) of the IDS. Nagao teaches a base support; a threaded shaft rotatably mounted to said base support; a first drive source fixedly mounted on said base support to rotate said threaded shaft; an elevating member engaged with said threaded shaft to move along said threaded shaft resulting from rotation of said threaded shaft so as thereby urge the friction agitation welding tool and the superposed plate workpieces together in the axial direction of welding; a first drive shaft mounted to said elevating member, rotatably about the axis of welding but fixedly in movement in the axial direction of welding, and mounting friction agitation welding tool to a distal end thereof; a second drive shaft mounted coaxially with said first drive shaft, fixedly in rotation relative to said first drive shaft but movably in an axial direction of said first drive shaft; and a second drive source fixedly mounted on said base support to rotate said second drive shaft (abstract; figures; paragraphs [0015]-[0025] of the translation); said elevating member comprises a cylindrical casing enclosing said first drive shaft therein and extending near said distal end of said first drive shaft, said cylindrical casing being mounted for axial movement to said base support through a bearing at a tip end opposite to said distal end (figures; paragraphs [0015]-[0025] of the translation); a back-

up tool fixedly mounted in aligned with and spaced apart from the friction agitation welding tool to said base support so as to support the superposed plate workpiece at a side remote from the friction agitation welding tool (figures; paragraphs [0015]-[0025] of the translation); said friction agitation welding apparatus is adapted to be detachably installed to a robot (paragraph [0014]).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 rejected under 35 U.S.C. 102(e) as being anticipated by Nagao (US-2004/0195290A1). Nagao teaches a base support; a threaded shaft rotatably mounted to said base support; a first drive source fixedly mounted on said base support to rotate said threaded shaft; an elevating member engaged with said threaded shaft to move along said threaded shaft resulting from rotation of said threaded shaft so as thereby urge the friction agitation welding tool and the superposed plate workpieces together in the axial direction of welding; a first drive shaft mounted to said elevating member, rotatably about the axis of welding but fixedly in movement in the axial direction of welding, and mounting friction agitation welding tool to a distal end thereof; a second drive shaft mounted coaxially with said first drive shaft, fixedly in rotation relative to said first drive shaft but movably in an axial direction of said first drive shaft; and a second drive source fixedly mounted on said base support to rotate said second drive shaft (abstract; figures; paragraphs [0012]-[0019] of the translation); said elevating member

comprises a cylindrical casing enclosing said first drive shaft therein and extending near said distal end of said first drive shaft, said cylindrical casing being mounted for axial movement to said base support through a bearing at a tip end opposite to said distal end (abstract; figures; paragraphs [0012]-[0019] of the translation); a back-up tool fixedly mounted in aligned with and spaced apart from the friction agitation welding tool to said base support so as to support the superposed plate workpiece at a side remote from the friction agitation welding tool (abstract; figures; paragraphs [0012]-[0019] of the translation); said friction agitation welding apparatus is adapted to be detachably installed to a robot (paragraph [0010]).

Conclusion

The prior art of record that is cited as of interest is presented on the form-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiley Stoner whose telephone number is (571) 272-1183. The examiner can normally be reached on Monday-Thursday (7:30 a.m. to 6:00 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on Monday-Friday at (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KILEY S. STONER
PRIMARY EXAMINER

Kyle Stoner 4/14/05